

- III. Claim 26, drawn to a method of filing soft tissue and further comprising administering cells wherein the cells are stem cells, Classified In Class 435, Subclass 325+.
- IV. Claims 27-30, drawn to a prosthetic device, Classified in Class 604, Subclass 1+.

II. ELECTION WITH TRAVERSE

Applicants elect, with traverse, for further prosecution the claims of Group IV.

In the Office Action it was stated that the inventions identified in the above-identified purported separate groups were distinct from each other for several reasons:

First, it was asserted that inventions of Groups I and IV were related as mutually exclusive species in an intermediate-final product relationship. It was stated that distinctness was proven for claims in this relationship if the intermediate product was useful to make other than the final product, and the species were patentably distinct. The MPEP §806.04(b), 3rd paragraph and MPEP §806.04(h) were relied upon for that assertion. According to the Examiner, in the instant case, the intermediate product was deemed to be useful as thickener in hair shampoos and the inventions were deemed patentably distinct since there was nothing in the record to show them to be obvious variants. Further, the Examiner stated that if the applicant traverses on the ground that the species were not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this was the case. Office Action, page 2. The Examiner indicated that in either case if the Examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under U.S.C. 103(a) of the other invention. Office Action, pages 2-3.

Second, it was asserted that Inventions I and II were related as product and process of use and that they can be shown to be distinct if either or both of the following can be shown:

1. the process for using the product as claimed can be practiced with another materially different product; or
2. the product as claimed can be used in a materially different process of using that product.

The MPEP, section 806.05(h) was relied upon for that assertion. It was said that in this instant case the product can be used for ophthalmic surgical procedures. Office Action, page 3.

Third, it was asserted that Groups II and III were different methods and that the methods were different because they used different steps which would produce different results. It was asserted that Group III employs the extra step of administering stem cells which was not a required method of Group I. Further, it was asserted that Groups II and III have different issues regarding patentability and enablement and represented patentably distinct subject matter. Office Action, page 3.

Fourth, it was asserted that because these inventions were distinct for the reasons summarized above and had acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated was proper. Office Action, page 3

Fifth, it was asserted that because these inventions were distinct for the summarized reasons and the search required for Group I was not required for Groups

II-IV, restriction for examination purposes as indicated was proper. Office Action, page 3.

Finally, it was asserted that these inventions were distinct for the reasons indicated in the Office Action and had acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated was proper. Further, it was stated that the different methods and products would require completely different searches in both the patent and non-patent databases, and there was no expectation that the searches would be coextensive. It was indicated that this created an undue search burden and so restriction for examination purposes was proper. Office Action, pages 3 & 4.

Applicant respectfully traverses the restriction requirement. To the best of Applicant's knowledge, the hydrogel as defined, in itself is novel and consequently, methods of using it were also novel, at the time of filing. Applicant considers it unreasonable for the Examiner to create another new invention relating to possible speculative uses of the novel hydrogel as grounds for lack of unity of invention.

Claims 1-13 (Group I) relate to a hydrogel for use as a soft tissue filler. Soft tissue fillers are endoprosthetics, which is related to the subject-matter of Claims 27-30 (Group IV). Therefore, Applicant submits that the two groups relate to similar inventions. Persons skilled in the art will understand that the hydrogel is not likely to be an intermediate to the final prosthetic product.

Furthermore, the Applicant respectfully disagrees with the statement in the Office Action that Groups II and III are distinct merely because in Group III the method further comprises the additional feature that one of the steps or an additional step comprises

the addition of stem cells. According to the Office Action, this will provide a different result. While the specific end result may be different, the overall result is likely to be the same, namely the cosmetic reparation of a soft-tissue area.

It is further submitted that the claims of the designated groups have not necessarily acquired a separate status in the art for examination purposes, notwithstanding possible different art classifications which may have been artificially assigned thereto in the U.S. Patent and Trademark Office. Art very relevant to the patentability of one group might very logically be found in the art classes assigned to one or all of the other claim groups. The classification cited in support of the election requirement is merely used for cataloging purposes and is not conclusive of the propriety of such a requirement. It is further submitted that an important advantage in pursuing just one application encompassing both, the catalyst composition and process claim groups is that the examination work of the Patent Office would be simplified, insofar as duplication of searching effort would be eliminated.

In view of the above remarks, it is respectfully requested that the restriction requirement be withdrawn and that all claims be allowed to be prosecuted in the same application. In the event that the requirement is made final, and in order to comply with 37 C.F.R. § 1.143, Applicants reaffirm the election of claims 27, 28, 29 and 30 (Group IV), holding the remaining claims (Groups I-III) in abeyance under the provisions of 37 C.F.R. § 1.142(b) until final disposition of the elected claims.

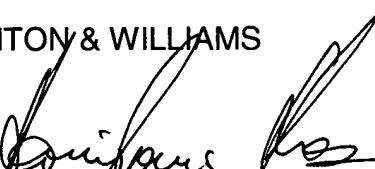
IV. REQUEST FOR ALLOWANCE

All claims are in condition for allowance, an indication of which is solicited. In the event any outstanding issues remain, Applicants would appreciate a telephone call to the undersigned counsel to resolve such issues in an expeditious and effective manner.

In the event that any additional fees are necessary, the Commissioner is hereby authorized to charge our Deposit Account No. 50-0206.

Respectfully submitted,

HUNTON & WILLIAMS

By: 
Stanislaus Aksman
Registration No. 28,562

Dated: March 3, 2003

1900 K Street, NW
Suite 1200
Washington, DC 20006
(202) 955-1926—Telephone
(202) 778-2201—Facsimile